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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,309	07/01/2004	David S. Bonalle	70655.1500	4308
20322	7590	05/02/2006	EXAMINER	
SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 85004-2202			WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/710,309	<b>Applicant(s)</b> BONALLE ET AL.	
	<b>Examiner</b> Daniel I. Walsh	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 4-19-06 (amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 19 April 2006.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1, the Examiner notes it is vague/indefinite how a biometric sample has a preset transaction limitation that is independent of the financial account limitation. It appears to the Examiner that the limitation associated with the biometric is somehow related to the account, as the biometric is related to the account. Is the Applicant suggesting that there is no relationship between the biometric limitation and the account limitation? Accordingly, if the account has a credit limit (\$10,000 maximum credit line for example) does a biometric sample have an independent limitation, and therefore could permit purchases of \$100,000? As best understood by the Examiner, the meaning of the "independence" is to distinguish that the biometric is not merely associated by extension to the account, but that it is used to establish security/limits on transactions as well, as taught by the prior art to Baer (see below) where different biometrics are used for different security levels.

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Re claim 13, it is unclear how a transaction limitation is overridden, as if it is overridden, it doesn't appear to be a limitation to start with. For purposes of Examination, upon referring to the Applicants specification (paragraph [0324] of 2006/0000893) it appears that the Applicant wants purchases that are above a certain level to require a biometric, and thus for purposes of Examination the Examiner will interpret the claims that way.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as cited in the previous Office Action, in view of Baer (US 2005/0232471).

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Re claim 1, Black teaches detecting a proffered biometric at a sensor communicating with the system, verifying the proffered biometric sample and authorizing a transaction upon verification of the proffered biometric sample (FIG. 1C and abstract).

Black is silent to determining whether the sample is associated with a preset transaction limitation independent of a financial account limitation and authorizing the transaction in compliance with the preset transaction limitation.

Baer teaches such limitations (paragraph [0037]). The limitation of Baer is interpreted to be independent of a financial account limitation, such as total credit limit of the card/account, for example.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Baer.

One would have been motivated to do this to have varying levels of security. It is obvious that the transaction would complete if in compliance, in order to execute the transaction.

Re claim 2, Black teaches the step of detecting included detecting a proffered biometric at a sensor configured to communicate with the system via at least one of a smartcard, reader, and network (FIG. 1C).

Re claim 3, Black teaches the step of detecting includes at least one of detecting, storing, and processing a proffered biometric sample (FIG. 1C and abstract).

Re claim 4, FIG. 1C shows a finite number of biometric samples are detected (fingerprint, signature).

Re claim 5, in Black teaches storing of digital and electronic signatures for record keeping purposes (paragraph [0125]). Additionally, the Examiner notes that biometric samples are stored/logged at least temporarily in other embodiments, just to compare/verify. The Examiner also notes McCall et al. (US 2003/0132297) which store/log signatures, Haala et al. (US 2005/0102524) which teaches recording details if authentication fails, and Segal et al. (US 2002/0066784) which teaches that a signature is bundled with transaction data and stored in a database to effect proof of a transaction.

Re claim 6, Bear teaches a second proffered sample, as discussed above. Additionally, Black teaches the step of detecting includes at least one of detecting, processing, and storing at least one second proffered biometric sample (FIG. 1C), which teaches both a signature and fingerprint.

Re claim 7, FIG. 1C teaches comparing a proffered biometric to a stored biometric.

Re claim 8, the Examiner notes that the proffered biometric is indeed compared with a sample of at least one of a criminal, a terrorist, and a card member (which should be the current card member) to authorize the transaction.

Re claim 9, Black teaches an embodiment where a transponder has information (fingerprint) stored on the device itself, and another embodiment where the signature is stored remotely (paragraph [0090]+) for security reasons. Accordingly, it is obvious that such data storage can be applied to a smartcard, as Black has already taught that the invention can relate to smartcard, transponders, etc. Therefore, it is obvious that the biometric sample would be verified using information contained remotely, such as in the instance when the signature is stored remotely (at customers bank). Though silent to the

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use of a database, the examiner notes that the use of a database as an obvious expedient for storing and accessing data on a computer device has been discussed above, and is obvious in order to have a means to access and retrieve data, well known in the art.

Re claim 10, Black teaches (FIG. 1A) that the host computer can store the reference data. The Examiner notes it would have been obvious for the samples to be stored in a third-party biometric security vendor or government agency as a means to provide secure storage. As the system of Black can be used for point of sale transactions, for example, it would have been obvious that the host computer would be remote from the transaction. Such secure storing of the samples would have been an obvious expedient to protect data and provide security. It is understood that a third party security vendor or government agency can provide such security, and therefore is an obvious expedient for the data storage.

Re claim 11, Black teaches that a unique identifier/customer number is associated with the user (FIG. 10A+). This is broadly interpreted as a personal identification number, or a unique means to verify a user/device. Additionally, the Examiner notes PIN-biometric combinations are well known and conventional in the art for increased security in systems. Therefore, using a PIN in addition to a biometric is an obvious expedient to increase security. The Examiner also notes that de Sylva teaches that prior art systems use biometric and PINs for access (paragraph [0013]).

Re claim 12, Black teaches a fingerprint scan, for example (FIG. 1A).

Re claim 13 and claim 16, it has been discussed above that the biometrics used to authorize transactions for varying security levels (different biometrics for different purchase values, for example). This is interpreted to include a maximum transaction

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account, as also discussed above. Additionally, the Examiner notes that as certain monetary amount transactions require different biometrics, that is interpreted to include overriding a preset transaction limitation on a credit card account, for example, as a different biometric may be provided for a larger amount purchase that requires a more secure biometric (retinal scan versus a fingerprint or facial scan, for example).

Re claim 15, a maximum transaction amount has been discussed above.

4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baer, as discussed above, in view of de Sylva.

The teachings of Black/Baer have been discussed above.

Black/Baer are silent to the sample being associated with at least two accounts, facilitating selection of an account, and authorizing a transaction with the selected account.

The Examiner notes that it is well known and conventional that a card/transponder can have consolidated accounts on it/access for many accounts, for convenience to the user (less cards carried). Along those lines, de Sylva teaches that one sample is associated with at least two accounts through user account list 30, and that one biometric is required based on user settings. Based on user settings, selection of an account is performed after verification for the transaction.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Baer with those of de Sylva.

One would have been motivated to do this in order to add convenience to the user.

***Additional Remarks***



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5. The Examiner notes that PINs associated with biometrics are well-known and conventional for increased security (versus just a biometric; see US 2001/0029493, 5,764,789, 2004/0084524, 2002/0174067, 2002/0062284, 2001/0018660 for example, which show that a PIN and biometric can be used for additional security over just a PIN or biometric, for example.) The Examiner also notes Royer et al. (US 2004/0155101) teaches the use of different biometrics with multiple accounts and Ramachandran (US 2001/0013551) and Pitroda (US 6,925,439) which teach consolidation of card accounts onto one card for convenience.

The Examiner notes that different levels of security are well know and conventional in the art. For example, Deo et al. (US 5,721,781) teaches based on transaction amounts, different information is required in order to provide security/assurance that the user is valid (see Fig. 9), Rasmussen et al. (US 6,834,795) teaches similar teachings (FIG. 5), and Tetro et al. (US 6,095,413) teaches added security trough use of a separate databases).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Deo et al. (US 5,721,781), Rasmussen et al. (US 6,834,795), and Tetro et al. (US 6,095,413).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh  
Examiner  
Art Unit 2876  
4-27-06

A handwritten signature in black ink, appearing to read 'DW', is located below the typed name and title of the examiner.